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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,497	10/13/2000	Takafumi Fujisawa	397.18.01	9408

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CHICAGO, IL 60603-3406

EXAMINER

FLANDERS, ANDREW C

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/687,497

Applicant(s)

FUJISAWA ET AL.

Examiner

Andrew C Flanders

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-8,10,13 and 14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3,6-8,10,13 and 14 is/are rejected.
7) ☒ Claim(s) 4 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 6 – 8, 11, 13 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows (U.S. Patent 6,377,530).

Regarding **Claims 1, 7, 8 and 14**, Burrows discloses a system for playing compressed audio data files (i.e. an entertainment apparatus for executing various programs), a user interface that includes one or more buttons (col. 4 lines 5 – 10) (i.e. at least one manual controller for entering control requests from the user into said entertainment apparatus), an audio output jack for playing user selected audio files (fig. 1 element 130) (i.e. audio output means for selecting and outputting one of a plurality of sound sources based on a supplied sound output command), a computer jack for connecting the player to a computer which will compress audio data from an audio CD (col. 4 lines 40 – 45). It is obvious that the CD contains audio data that has already been sampled, usually at a rate of 44.1 kHz. Digitizing an audio file requires a sampling of the audio file and CD's contain digital audio files. Moreover, it would have been obvious to one of ordinary skill in the art to use a computer such as the one disclosed by Burrows, to digitize and record digital audio files upon a CD (i.e. sampling means for

selectively sampling audio data from audio data during reproduction and registering said sampled audio data in a first file). Digitizing analog audio using a personal computer is just one of the many uses that were notoriously well known to one of ordinary skill in the art at the time of the invention. Furthermore, the system recompresses the CD data into an MP3 or similar format to place onto the portable player (col. 4 lines 35 – 45) and the files selected from the CD can be input by a user (col. 4 lines 63 – 67) (i.e. re-sampling means to be selectively activated based on a request from said user for selectively re-sampling audio data from audio data registered in said first file when reproducing said audio data registered in said first file, the re-sampling means registering said re-sampled audio data in a second file), transferring audio files to the player and storing them on the hard drive via the computer jack for playback based upon user requests (col. 4 lines 27 – 67) (i.e. audio data registering means for registering said audio data registered in said first file or said audio data registered in said second file based on a request from said user as one of said sound sources for said entertainment apparatus).

Regarding **Claims 6 and 13**, in addition to the elements stated above regarding claim 1, Burrows discloses a user selecting tracks to be played by the system (col. 4 lines 65 – 67) (i.e. selecting playback means for reproducing said audio data registered in said first file according to a playback attribute selected according to a control input entered from said manual controller).

Regarding **Claim 11**, in addition to the elements stated above regarding claim 8, Burrows doesn't disclose applying an effect to said audio data being input from outside based on a request from said user; and applying an effect to said audio data registered

in said first file when reproducing said audio data registered in said first file. However, Examiner takes official notice that it is obvious to provide the user with effects to be implemented during playback. A common effect which would read upon the claimed limitations of claim 11 would include a volume adjustment. Burrows does not explicitly disclose a volume adjustment, but it would have been obvious for one of ordinary skill in the art at the time of the invention to include one to alter the playback level (i.e. applying an effect to said audio data being input from outside based on a request from said user; and applying an effect to said audio data registered in said first file when reproducing said audio data registered in said first file).

3. **Claims 3 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows (U.S. Patent 6,377,530) in view of Keller (U.S. Patent 6,172,948).

Regarding **Claims 3 and 10**, in addition to the elements stated above regarding claim 1, Keller discloses to trim a stored sound track (col. 4 lines 40 and 41) (i.e. wave editing means for trimming said audio data registered in said first file and/or said second file based on a request from said user). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Keller's trimming means on Burrows Computer system. Audio editing via a computer was notoriously well known at the time of the invention. One would be motivated to edit the sound files via trimming in order to create a collage of sound clips that might be used for a performance using the portable player where an expensive performance system is not an option.

Allowable Subject Matter

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to **claims 1, 3, 4, 6 – 8, 10, 11, 13 and 14** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SINH TRAN
SUPERVISORY PATENT EXAMINER

acf